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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,922	09/05/2003	Jose Luis Moctezuma de la Barrera	29997/062	8618

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EXAMINER

SHAY, DAVID M

ART UNIT	PAPER NUMBER
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3735

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/655,922

Applicant(s)

OCTEZUMA DE LA BARRERA

Examiner

david shay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on June 5, 2006
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-122 is/are pending in the application.
- 4a) Of the above claim(s) 54-88 and 107-122 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-53 and 89-106 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

The drawings corrections filed June 15, 2006 are accepted.

Applicant argues that Carson et al do not disclose the construction of a model intraoperatively. The examiner must respectfully disagree. Applicant is respectfully reminded that the disclosures of the prior art are evaluated for what it would teach person having ordinary skill in the art and as such, the disclosure regarding imageless systems which is discussed as “resulting in longer operating room time” is clearly done intraoperatively. As to applicant’s assertion that the disclosure of the imageless systems discusses disadvantages of the various systems, the examiner notes that this is in and of itself not probative of use of the teaching. The mere recitation of the the particular imageless system taking more operating room time would not dissuade person having ordinary skill in the art from employing such a system (see *In re Gurley* 31 USPQ2d 1130), apart from the fact that it is clear from the disclosure of Carlson et al that such systems were in use for joint replacement surgery. Applicant continues, asserting that “Carson does not provide any description of the modeling step”. The examiner must respectfully note that Carson et al do discuss “digitizing a large number of points to define the complex geometries of the knee at each desired site” (column 4, lines 21-22) and it is unclear to the examiner what applicant is envisioning the term “modeling” to encompass, if the passage at lines 21-22 is to be excluded therefrom. With respect to Salehi et al, applicant argues that there is no disclosure of preparing the joint. Firstly, it is noted that the precise manner of preparation is well known to person having ordinary skill in the art, as is evident from the instant disclosure at page 10, lines 10-30, and the total absence of any specific discussion of the manner of broaching or various planes. Secondly, it is noted that Salehi et al was never put forth as providing this teaching by the examiner. Applicant also posits that there is no motivation to combine the

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references, and even if so combined, the combination would not read on the claims, however no factual basis is put forth for these suppositions, and as such the examiner is at a loss to refute them further. Regarding the combination involving DiGioia (NPL), applicant asserts that “[T]he method of DiGioia is based on scans and not based on locating anatomical landmarks of the patient intraoperatively.” The examiner must respectfully disagree. A careful reading of DiGioia et al reveals the use of “optical targets equipped with light emitting diodes...Multiple points on the surface of the pelvis are collected with an optically tracked digitizing probe during surgery” (see DeGioia et al, page 12) clearly an intraoperative model is made based on anatomical landmarks. Lastly with respect to the combination including Gustilo et al, applicant asserts that there is “no disclosure of the subject matter of claims 13 and 40 in Gustilo”. The examiner must respectfully point out that the teachings of Gustilo et al do include relating the depth to the medial wall of the acetabulum.

The examiner notes applicant’s request to hold the provisional obviousness double patenting rejections in abeyance. The examiner must regretfully inform applicant that this is not the policy of the patent office – all applicable rejections must be made. However it is pointed out that the submission of a terminal disclaimer will obviate this rejection.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “determining joint range of motion of the joint” and “determining stability of the joint” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing

sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claims 1-5, 7, 8, 14, 15, 21-26, 28-32, 35, 41, 42, and 89-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carson et al in combination with Salehi et al. Carson et al teach a method as claimed except for any discussion of the placement of the stem and use of the sagittal and coronal planes. Salehi et al teach the equivalence of stems and other means for attaching implants to the bones they are to be mounted on. It would have been obvious to the artisan or ordinary skill to employ an implant with a stem in the method of Carson et al since these are equivalent to other attachment means, as taught by Salehi et al, thus producing a method and method such as claimed.

Claims 1-12, 14-39, 41-53, and 89-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carson et al as applied to claims 1-5, 7, 8, 14, 15, 21-26, 28-32, 35, 41, 42, and 89-93 above, and further in combination with DiGioia et al (NPL). DiGioia et al (NPL)

teach a method as claimed except for the specific recitation of producing a three-dimensional model of the joint per se. It would have been obvious to the artisan of ordinary skill to provide the method of DiGioia et al (NPL) in the method of Carson et al, since this will provide a better fit and reduce the incidences of dislocations, as taught by DiGioia et al (NPL) or alternatively to include the three-dimensional rendering of the joint in of Carson et al in the method of DiGioia et al (NPL), since this would enable the more efficient and realistic determination of and visualization of the appropriate placement of the portions of the implant, thus producing a method such as claimed.

Claims 13 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carson et al in combination with Salehi et al as applied to claims 1-5, 7, 8, 14, 15, 21-26, 28-32, 35, 41, 42, and 89-93 above or Carson et al in combination with DiGioia et al (NPL) as applied to claims 1-12, 14-39, 41-53, and 89-106 above, and further in view of Gustilo et al. Gustilo et al teaches that relating the depth of the reaming to the depth of the medial wall maximizes the stability of the prosthesis. It would have been obvious to the artisan of ordinary skill to relate the depth of the reaming to the depth of the medial wall in the combined methods of Carson et al and Salehi et al and Carson et al and DiGioia et al (NPL) maximizes the stability of the prosthesis, as taught by Gustilo et al, thus producing a method such as claimed.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-53 and 89-106 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 24-46 of copending Application No. 10/732,553. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application anticipate the claims of the instant application. Accordingly, instant application claims are not patentably distinct from the copending application claims. Here, the copending application claims require elements A, B, C, and D while instant application claims only requires elements A, B, and C. Thus it is apparent that the more specific patent application claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 1-53 and 89-106 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-35 of copending Application No. 11/148,520. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application anticipate the

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claims of the instant application. Accordingly, instant application claims are not patentably distinct from the copending application claims. Here, the copending application claims require elements A, B, C, and D while instant application claims only requires elements A, B, and C. Thus it is apparent that the more specific patent application claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

This is a provisional obviousness-type double patenting rejection.

Applicant's arguments filed June 15, 2006 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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